

Remarks

This paper is responsive to the Final Office Action mailed February 17, 2005, which set a three-month shortened statutory period for response, to end May 17, 2005. This paper is timely filed within two months of the Final Office Action.

In the Action, the Office finally rejected claims 1, and 23-28 under 35 U.S.C. § 112, first paragraph and second paragraph. In response to the Office Action, applicant amends claim 1 and cancels claim 26 to address the Office's objections, leaving claims 1, 23-25, and 27-28 pending in this application.

Telephone Interview

Applicant's representatives Sean Myers-Payne and Milan Jovanovic sincerely thank Examiner Larry R. Helms for the telephone interview on April 15, 2005. The outstanding rejections were discussed, as were proposed amendments. The Examiner offered to consider Applicant's proposed amendments.

Claim Rejections - 35 U.S.C. § 112, First Paragraph

The Office rejects claims 1 and 23-28 under 35 U.S.C. § 112, first paragraph, as allegedly failing to satisfy the written description requirements, alleging the specification does not teach the DESC1 gene and in addition the specification does not teach variants of DESC1. The Office also rejects claims 1 and 23-28 under 35 U.S.C. § 112, first paragraph, as allegedly failing to satisfy the enablement requirements.

Applicant respectfully submits that the written description and enablement requirements were satisfied with regard to claim 1. Nevertheless, Applicant has amended claim 1 to recite “. . . assaying for presence of DESC1 mRNA in the sample, using at least one nucleic acid that hybridizes with the DESC1 mRNA under conditions about 5° to about 20° Celsius below the T_m

of said nucleic acid” Applicant submits that the amended claims are sufficiently described in and enabled by the specification. Numerous working examples falling within the scope of the amended claims are provided. Thus, Applicant submits that the amendment is totally responsive to the rejections.

Claim Rejections - 35 U.S.C. § 112, Second Paragraph

The Office rejects claims 1 and 23-28 under 35 U.S.C. § 112, second paragraph, as being indefinite for reciting “wherein reduced DESC1 expression,” alleging it is not clear what the reduction is compared to.

Applicant has amended claim 1 to recite “. . . wherein reduced level of DESC1 mRNA, as compared to a normal tissue sample taken from the same tissue of the same subject” Thus, it is now even clearer how the comparison is made.

Conclusion

Applicant submits that the proposed amendments do not raise new issues or necessitate the undertaking of any additional search of the art by the Examiner, since all of the elements and their relationships claimed were either earlier claimed or inherent in the claims as examined. Therefore, this Amendment should allow for immediate action by the Examiner.

Furthermore, Applicant respectfully points out that the final action by the Examiner presented a new rejection. Applicant respectfully submits that the entering of the Amendment would allow Applicant to reply to the final rejections and place the application in condition for allowance.

Finally, Applicant submits that the entry of the amendment would place the application in better form for appeal, should the Examiner dispute the patentability of the pending claims.

Application No. 09/674,035
Attorney Docket No. 22727/04078
Response to Office Action

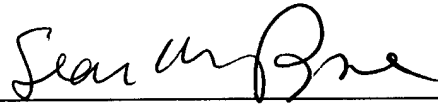
In view of the foregoing remarks, Applicant submits that this claimed invention, as amended, is allowable. Applicant therefore requests the entry of this Amendment, the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

If there is any fee due in connection with the filing of this Response, please charge the fee to our Deposit Account No. 03-0172.

Respectfully submitted,

Date:

April 15, 2005



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